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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
08/905,501	08/04/97	SCROGGIE M	CAT/29US

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EXAMINER

KAZIMI, H

ART UNIT	PAPER NUMBER
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2765

DATE MAILED: 05/05/99

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.
08/905,501

Applicant(s)
Scroggie et al.

Examiner
Hani Kazimi

Group Art Unit
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☒ Responsive to communication(s) filed on Feb 12, 1999

☒ This action is **FINAL**.

☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire 3 month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

Disposition of Claims

☒ Claim(s) 1-110 is/are pending in the application.

Of the above, claim(s) 1-31 is/are withdrawn from consideration.

☐ Claim(s) _____ is/are allowed.

☒ Claim(s) 32-110 is/are rejected.

☐ Claim(s) _____ is/are objected to.

☐ Claims _____ are subject to restriction or election requirement.

Application Papers

☐ See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.

☐ The drawing(s) filed on _____ is/are objected to by the Examiner.

☐ The proposed drawing correction, filed on _____ is ☐ approved ☐ disapproved.

☐ The specification is objected to by the Examiner.

☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

☐ Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).

☐ All ☐ Some* ☐ None of the CERTIFIED copies of the priority documents have been
☐ received.

☐ received in Application No. (Series Code/Serial Number) _____.

☐ received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

*Certified copies not received: _____

☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

☒ Notice of References Cited, PTO-892

☒ Information Disclosure Statement(s), PTO-1449, Paper No(s). 7, and 10

☐ Interview Summary, PTO-413

☐ Notice of Draftsperson's Patent Drawing Review, PTO-948

☐ Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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DETAILED ACTION

1. This communication is responsive to the amendment filed on February 12, 1999.

Status of Claims

2. Of the original and added claims 1-31, claims 1-31 have been canceled, and claims 32-110 have been added by Applicants' amendment filed on February 12, 1999. Therefore, claims 32-110 are under prosecution in this application.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

4. Claims 56, 57, 82, 83, and 108-110 are rejected under 35 U.S.C. 102(e) as being anticipated by Christensen et al. US Pat. No. 5,710,886.

Claims 56, 82, and 108, Christensen discloses a computer implemented method for adding data identifying products purchased by a consumer in association with data uniquely identifying said consumer in a database (column 10, lines 42-61), said method comprising the steps of:

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determining retail store purchased products purchased in a retail store in association with a unique identity code (column 10, lines 42-61);

storing data identifying said store purchased products in association with said unique identity code in said database (column 10, lines 42-61);

determining network purchased products purchased via a communication over a computer network in association with said unique identity code (column 16, line 27 thru column 17, line 11, and); and

storing data identifying said network purchased products in association with said unique identify code in said database (column 16, line 27 thru column 17, line 11).

Claims 57, 83, and 109, Christensen discloses that the computer network comprises one of an intranet and the Internet (column 16, lines 27-35).

Claim 110, Christensen discloses that the computer network is the Internet and purchase of said purchased products occurs via interaction with a web page (column 16, lines 27-35).

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the

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manner in which the invention was made.

6. The factual inquiries set forth in *Graham v. John Deere Co.*, 148 USPQ 459, that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or unobviousness.

7. Claims 32-42, 58-68, and 84-94 are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen et al. US Pat. No. 5,710,886.

Claims 32, 58, and 84, Christensen teaches a computer implemented method for providing purchasing incentives to consumers (column 4, lines 15-33), comprising the steps of:

storing in a purchase history database product data for products purchased in association with a unique identifier (fig. 5, element 514, column 4, lines 15-33, and column 10, lines 53-61);

transmitting a prompt for personal information from a main computer to a personal computer over a computer network (column 4, lines 15-43);

transmitting personal information data from said personal computer to said main computer over said computer network in response to said prompt (column 4, lines 15-43);

generating package of data defining a group of consumers that is accessible over said computer network, said package of data based at least in part on said personal information data

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transmitted from said personal computer to said main computer (column 4, lines 15-43);

storing said package of data defining a group of consumers in a database (column 4, lines 15-43);

determining a purchase incentive depending on (1) said product data stored in said purchase history database and (2) said package of data stored in said database (column 4, lines 15-43, and column 10, lines 53-61); and

updating said package of data so that said package of data will display said purchase incentive (column 4, lines 34-43).

Christensen fails to teach that the package of data is in the form of a personal page.

Official notice is taken that establishing a personal page in a computer network is old and well known in the art.

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Christensen to include the establishing step of a personal page in a computer network because, the use of personal pages on the Internet will cover a broader range of distribution, and greatly improves the efficiency of updating the data files in the database.

Claims 33, 59, and 85, Christensen teaches the step of storing said package of data in association with said unique identifier (column 11, line 27 thru column 12, line 12).

Claims 34, 60, and 86, Christensen teaches the step of storing in said purchase history

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database said product data for products purchased in association with said unique identifier, whereby said unique identifier uniquely identifies a consumer (column 10, lines 53-61, and column 11, line 27 thru column 12, line 12).

Claims 35, 61, and 87, Christensen teaches the step of transmitting an advisory message concerning said updated package of data from said main computer to said personal computer over said computer network (column 4, lines 34-43).

Claims 36, 62, and 88, Christensen teaches the step of determining said purchase incentive based on offers from a product manufacturer (column 16, lines 9-35).

Claims 37, 63, and 89, Christensen teaches the step of determining said purchase incentive based on offers from a product retailer (column 16, lines 9-35).

Claims 38, 64, and 90, Christensen teaches the step of determining said purchase incentive based on offers from a product manufacturer and offers from a product retailer (column 16, lines 9-35).

Claims 39, 65, and 91, Christensen teaches the step of determining said purchase incentive on a basis of demographic data stored in said database (column 15, line 64 thru column 16, line 67).

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Claims 40, 66, and 92, Christensen teaches the step of determining said purchase incentive on a basis a frequency of usage of purchase incentives by a consumer (column 10, line 62 thru column 11, line 27).

Claims 41, 67, and 93, Christensen fails to teach the step of determining said purchase incentive on a basis a frequency of usage of said personal page by a consumer.

Official notice is taken that tracking the use of a personal page in a computer network is old and well known in the art.

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Christensen to include the step of determining the purchase incentive on a basis a frequency of usage of the personal page by a consumer because, by tracking the usage of a personal page provides a more efficient system in targeting consumers and distributing of coupon data.

Claims 42, 68, and 94, Christensen teaches that the computer network comprises one of an intranet and the Internet (column 16, lines 27-35).

8. Claims 43-55, 69-81, and 95-107, are rejected under 35 U.S.C. 103(a) as being unpatentable over Christensen et al. US Pat. No. 5,710,886 in view of Von Kohorn US Pat. No. 5,249,044.

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Claims 43, 69, and 95, Christensen teaches a computer implemented method for distributing purchasing incentives to consumers (column 4, lines 15-33), comprising the steps of:

transmitting promotion data identifying a plurality of product discounts from a main computer to a personal computer over a computer network (column 4, lines 15-43);

displaying; said plurality of product discounts at said personal computer based on said promotion data (column 4, lines 15-43);

transmitting selection data designating at least one product discount selected from said plurality of product discounts from said personal computer to said main computer over said computer network (column 4, lines 15-43);

generating a package of coupon data depending on said selection data (column 4, lines 15-43);

transmitting said coupon from said main computer to said personal computer over said computer network (column 4, lines 15-43);

identifying said coupon in a retail store in association with items being purchased at said retail store (column 4, lines 15-43);

determining discount items being purchased corresponding to said at least one product discount from said identified coupon (column 10, lines 22-31); and

generating a purchase incentive that provides a cash discount, said cash discount based on said discount items (column 10, lines 22-31, and column 1, lines 13-25).

Christensen fails to teach that the package of data is in the form of a token.

Von Kohorn teaches a method and system for generating and redeeming tokens depending

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on a selection data (column 6, line 62 thru column 7, line 18).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Christensen to include the use of a token data because, both Christensen and Von Kohorn generate purchase incentives at remote locations, and also the use of a token provides a more efficient system in detecting fraud.

Claims 44, 45, 70, 71, 96, and 97, Christensen teaches that the coupon may be provided with printed indicia indicating product and discount or rebate, as well as traditional redemption terms (column 9, lines 60-67).

Christensen fails to explicitly teach the steps of generating an instantly redeemable voucher, and generating a voucher that is redeemable on a subsequent visit to said retail store.

However, the specifications of redemption terms such as an instantly redeemable voucher, or a voucher that is redeemable on a subsequent visit is a designer's choice.

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Christensen to include the steps of generating an instantly redeemable voucher, and generating a voucher that is redeemable on a subsequent visit to said retail store because, it provides convenience to the customer.

Claims 46, 47, 72, 73, 98, and 99, both Christensen and Von Kohorn fail to teach the steps of generating a shopping list based on said selected product discounts, and transmitting said shopping list from said main computer to said personal computer over said computer network.

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Official notice is taken that generating a shopping list, and transmitting the shopping list over a computer network is old and well known in the art.

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Christensen to include the steps of generating a shopping list based on said selected product discounts, and transmitting said shopping list from said main computer to said personal computer over said computer network because, it provides the user with a system that is more efficient and user friendly.

Claims 48, 74, and 100, Christensen teaches the step of transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer (column 16, lines 9-35).

Claims 49, 75, and 101, Christensen teaches the step of transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified retailer (column 16, lines 9-35).

Claims 50, 76, and 102, Christensen teaches the step of transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts from a specified product manufacturer and from a specified product retailer (column 16, lines 9-35).

Claims 51, 77, and 103, Christensen teaches the step of transmitting said promotion data

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comprises transmitting promotion data identifying a plurality of product discounts on a basis of demographic data stored in a personal database of a consumer (column 15, line 64 thru column 16, line 67).

Claims 52, 78, and 104, Christensen teaches the step of transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of coupons by a consumer (column 10, line 62 thru column 11, line 27).

Christensen fails to teach the use of a token.

Von Kohorn teaches the use of a token (column 6, line 62 thru column 7, line 18).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Christensen to include the use of a token because, both Christensen and Von Kohorn generate purchase incentives at remote locations, and also the use of a token provides a more efficient system in detecting fraud.

Claims 53, 79, and 105, Christensen teaches the step of transmitting said promotion data comprises transmitting promotion data identifying a plurality of product discounts on a basis of a frequency of usage of product discounts by a consumer (column 10, line 62 thru column 11, line 27).

Claims 54, 80, and 106, Christensen teaches the step of identifying said coupon data comprises identifying said coupon data by scanning a coupon having said coupon data therein

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(column 10, lines 22-31).

Christensen fails to teach the use of a token.

Von Kohorn teaches the step of identifying said token data comprises identifying said token data by scanning a token having said token data therein (column 4, line 52 thru column 5, line 17).

Therefore, it would have been obvious to one of ordinary skilled in the art at the time the applicant's invention was made to modify the teachings of Christensen to include the use of a token data because, both Christensen and Von Kohorn generate purchase incentives at remote locations, and also the use of a token provides a more efficient system in detecting fraud.

Claims 55, 81, and 107, Christensen teaches that the computer network comprises one of an intranet and the Internet (column 16, lines 27-35).

Response to Arguments

9. Applicant's arguments with respect to claims 27-31, have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

10. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

11. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Hani Kazimi whose telephone number is (703) 305-1061. The examiner can normally be reached Monday-Friday from 8:30 AM to 5:00 PM.


If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Allen MacDonald, can be reached at (703) 305-9708.

The fax number for Formal or Official faxes to Technology Center 2700 is (703) 308-9051 or 9052. Draft or Informal faxes for this Art Unit can be submitted to (703) 308-5357.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 305-3900.

Hani Kazimi

April 26, 1999



ALLEN R. MACDONALD
SUPERVISORY PATENT EXAMINER